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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/931,005	08/17/2001	Robert W. Scheifler	6502.0113-01	2982
22852	7590	11/18/2005		
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413				
			EXAMINER LEROUX, ETIENNE PIERRE	
			ART UNIT 2161	PAPER NUMBER

DATE MAILED: 11/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/931,005	SCHEIFLER ET AL.	
	Examiner	Art Unit	
	Etienne P LeRoux	2161	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 September 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 28-88 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 28-88 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>9/2005</u> . | 6) <input type="checkbox"/> Other: _____ |

Withdrawal of Final Rejection

Applicant's request for reconsideration in Pre-Appeal Brief Request for Review, filed September 30, 2005 has been considered and is persuasive and, therefore, the finality of the prosecution record is withdrawn.

Claims Status:

Claims 28-88 are pending. Claims 1-27 have been cancelled. Claims 28-88 are rejected as detailed below.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 62-88 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Recently added claims 62-88 contain subject matter which was not described in the specification in such a way as to reasonable convey to one skilled in the art that the inventors at the time the application was filed, had possession of the claimed invention. Claims 62, 71, 75, 78, 80, 81 and 85 include "transforming parameters into different types for subsequent transmission." Applicant relies upon US Pat No 6,393,497 which was incorporated by reference for an explanation of the concept of a smart proxy and furthermore, applicant relies upon the knowledge of the skilled artisan for a definition

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of 'parameter.' Applicant fails to disclose the relevance of 'smart proxy' and a prior art definition of 'parameters' to the above claim limitation. Examiner concludes that claims 62-88 contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventors at the time the application was filed, had possession of the claimed invention.

Art Rejection Precluded.

Claims 62-88 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 28-61 are rejected under 35 U.S.C. 102(e) as being anticipated by Pub No US 2001/0003825 issued to Schnier.

Claims 28, 37, 44, 45, 46, 49 and 55:

Schnier discloses:

receiving a request from a client [Fig 5, step 502, client accesses server, paragraph 90] by the lookup service [Fig 4, 100 – server system] for access to one of the network services [access to one of the objects residing on the server system, paragraph 90, remote server paragraph 79]

returning a resource locator [TCP/IP address, paragraph 38] to the client from the lookup service so that the client may dynamically load executable code [dynamically loaded, paragraph 51]

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Claims 29, 38, 47 and 56:

Schnier discloses using the returned resource locator to dynamically load executable code to facilitate access of the one network service [paragraph 51]

Claims 30, 39, 41, 43, 48, 51, 54, 57, 59:

Schnier discloses accessing the network service by the client using the dynamically loaded executable code [paragraph 51]

Claim 31:

Schnier discloses wherein the step of returning a resource locator includes the step of returning the stub information to the client [paragraphs 51, 79 and 90]

Claims 32, 50 and 58:

Schnier discloses using the resource locator in the client to dynamically load executable code for the stub [paragraphs 51, 79 and 90]

Claims 33, 40 and 61:

Schnier discloses accessing the network service by the client using the dynamically loaded executable code [paragraphs 51, 79 and 90]

Claims 34 and 52:

Schnier discloses returning smart proxy information to the client [paragraphs 51, 79 and 90]

Claims 35 and 53:

Schnier discloses using the resource locator in the client to dynamically load executable code for the smart proxy [paragraphs 51, 79 and 90]

Claim 36:

Schnier discloses accessing the network service by the client using the dynamically loaded executable code [paragraphs 51, 79 and 90]

Claims 42 and 60:

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Schnier discloses receiving smart proxy information and using the resource locator to dynamically load executable code for a smart proxy [paragraphs 51, 79 and 90]

Response to Arguments

Applicant's arguments filed September 30, 2005 in Pre-appeal Brief Request for Review have been fully considered and found partially persuasive. The partially persuasive arguments are now moot in view above new grounds of rejection. The following argument(s) were not persuasive.

Applicant Argues:

Applicant argues that the rejection of “transforming parameters associated with the request into different types of parameters appropriate for subsequent transmission” under the first paragraph of 35 USC 112 is improper.

Examiner Responds:

Examiner is not is not persuaded. Claims 62-88 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Recently added claims 62-88 contain subject matter which was not described in the specification in such a way as to reasonable convey to one skilled in the art that the inventors at the time the application was filed, had possession of the claimed invention. Claims 62, 71, 75, 78, 80, 81 and 85 include “transforming parameters into different types for subsequent transmission.” Applicant relies upon US Pat No 6,393,497 which was incorporated by reference for an explanation of the concept of a smart proxy and furthermore, applicant relies upon the knowledge of the skilled artisan for a definition

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of 'parameter.' Applicant fails to disclose the relevance of 'smart proxy' and a prior art definition of 'parameters' to the above claim limitation.

Paragraph 80 of the specification of the present application states "If the situation called for it, a smart proxy might transform the parameters received from the client into other types and then send the transformed types." One of ordinary skill in the art would not be able to ascertain what parameters are received from the client since the essence of the present invention is returning a resource locator and executable code **from** (emphasis added) the lookup service **to** (emphasis added) the client. Furthermore, the specification does not describe how the parameters are transformed nor does the specification describe where the transformed parameters are sent. The specification statement "[i]f the situation called for it" is confusing because the conditions under which the parameters are required to be transformed are not described in the specification.

Applicant states in Pre-Appeal Brief Request for Review, filed September 30, 2005, the following:

The examiner has not demonstrated why one of ordinary skill in the art would not have recognized the description of a smart proxy in page 30 of Applicant's specification does not meet the written description requirement of the above noted claims. Indeed, it appears the examiner did not even consider the disclosure of application No. 09/044,930, now U.S. Patent No. 6,393,497 that is incorporated by reference and explains the smart proxy concept. (See specification at 30 and Amendment filed May 31, 2005, at 7). Further, as explained, the 'parameters' recited in the above noted claims and in page 30 of the specification would have been known to one of ordinary skill in the noted field of endeavor associated with this application.

Examiner is not persuaded. The disclosure of Application No 09/044,930, now US Patent No. 6,393,497, as maintained above by applicant, explains the smart concept. Furthermore, regarding "parameters" applicant relies upon what is well-known and expected in the art. A well-known definition¹ of parameter is the following:

¹ Microsoft Computer Dictionary, Fifth Edition

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In programming, a value that is given to a variable, either at the beginning of an operation or before the expression is evaluated by a program. Until the operation is completed, a parameter is effectively treated as a constant value by the program. A parameter can be text, a number, or an argument name assigned to a value that is passed from one routine to another. Parameters are used as a means of customizing program operation.

Examiner maintains that U.S. Patent No. 6,393, 497 which merely explains the concept of a smart proxy and the above prior-art definition of "parameter" which has many different possible applications in many different situations, are not sufficient disclosure for the claim limitation "transforming parameters into different types for subsequent transmission." A skilled artisan would not be able to make and use the present invention without undue experimentation.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Etienne P. LeRoux whose telephone number is (571) 272-4022. The examiner can normally be reached Monday through Friday between 8:00am and 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on (571) 272-4023. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

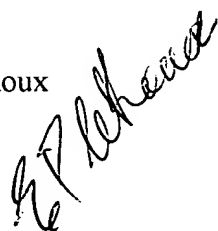
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Etienne LeRoux

11/11/2005

A handwritten signature in black ink, appearing to read 'Etienne LeRoux', written diagonally across the printed name and date.